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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/876,937	06/16/1997	DAVID F. WOODWARD	16955DIVCONC	5537

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EXAMINER
O SULLIVAN, PETER G

ART UNIT	PAPER NUMBER
1621	

DATE MAILED: 05/07/2002 26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/876,937	Applicant(s) Woodward et al.
	Examiner Peter O'Sullivan	Art Unit 1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Feb 22, 2002* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *26-48* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) *46 and 47* is/are allowed.

6) ☒ Claim(s) *26-45 and 48* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

1. Claims 26-48 are pending in this application. The finality of the previous office action is withdrawn to make a new ground of rejection. If the applicants would like to resubmit a brief in response to this action, they may do so.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 26, 28-34, 36-45 and 48 are again rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for R1 as H, lower alkyl or a cation, does not reasonably provide enablement for applicants added groups. The applicants' arguments have been given due consideration, but are found non-persuasive. Regarding applicants' comments at the middle of page 3 of the last action, Bishop et al. '383 does not teach covalently bonded amino as in some of applicants' compounds, but rather ionic compounds at line 55 of column 3. Tromethamine would be quaternary ammonium compound. Although applicants argue that since Bishop et al. '383 teach conventional methods may be used to make some compounds that it would have been obvious how to make applicants' added compounds, 35 U.S.C. 112, first paragraph, concerns not only the making of an invention but using it as well. Applicants do not show how to use the newly added groups in their origional specification. Regarding claims 42-45, the claiming is "an acceptable ester moiety" would include groups other than alkyl which are not enabled by applicants' specification. Alkyl esters are only one type of ester. Claim 48 claims a

composition for treating primates, but only pharmaceutical not veterinary treatments are disclosed in applicants' specification.

4. Claims 26, 28-34, 36-45 and 48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' have added claims wherein R1 can be groups beyond H, lower alkyl or cation.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 26-45 are again rejected under 35 U.S.C. 102(e) as being anticipated by Bishop et al. U.S. '383. Claims 26-45 of this application has been copied from U.S. Patent No. 5,510,383. Contra applicants' arguments, Bishop et al. '383 discloses specific ester compounds not disclosed in Woodward '708.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 26-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop '383. Applicants' arguments have been given due consideration, but are held to be non-persuasive. Bishop et al. disclose compounds of general formula I to be useful in treating glaucoma and ocular hypertension. In said formula, R1 may be hydrogen, a cationic salt moiety, a pharmaceuticaly acceptable amine moiety or C1-C12 alkyl, cycloalkyl or aryl and R2 may be cloro or trifluoromethyl. The instant invention differs from the teaching of the cited reference in although generically disclosed, not all of the compounds are specifically exemplified in the reference. It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art to start with the teaching of the cited references, to make other of applicants' compounds in view of compounds actually made in the Bishop et al. '383 reference and to expect them to be useful in the treatment of glaucoma and ocular hypertension. As opposed to the 112 rejection, where applicants' specification does not show the added groups, Bishop et al. do disclose them.

9. Claim 46 and 47 are not rejected, but are subject to a possible interference.

10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication should be directed to Peter O'Sullivan at telephone number (703) 308-4526.

PETER O'SULLIVAN
PRIMARY EXAMINER
GROUP 1200